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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,998	06/13/2001	Yoshio Awakura	01316LH	4025

1933 7590 12/10/2002

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

11

DATE MAILED: 12/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-11

# Office Action Summary

Application No.

09/857,998

Applicant(s)

AWAKURA ET AL.

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,6,12,13 and 16 is/are rejected.
- 7) ☒ Claim(s) 4,5,7-10,14,15 and 17-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Claim Rejections - 35 USC § 112***

The rejection over claims 8-10 and 18-20 is hereby withdrawn in view of Applicants response.

***Claim Rejections - 35 USC § 102***

Previously, the Examiner held various claims of the present disclosure as being anticipated by *Suzuki, Maeda, Watanabe, Takoaka, or Kobayashi*. The rejections over Suzuki and Takaoka were improper insofar as the publication dates of these documents do not antedate the international filing date. *Kobayashi* is obviated by Applicant's submission of a corresponding translation of the foreign priority paper.

As for Watanabe, the Examiner deemed this patent an anticipatory reference because the precise meaning of a "soft magnetic" powder had not been precisely delineated and, as such, could be conveniently defined in any of a number of different ways. However, the Applicant has demonstrated that the aforementioned phrase has acquired a well-accepted meaning in the art, i.e. a magnetic powder having high coercivity. It is not clear that the metals mentioned in *Junichiro* possess this characteristic hence the rejection over this reference is also withdrawn. Applicant will, of course, be held to the definition outlined on page 9 of their response.

Finally, claims 1-3 and 11-13 were rejected under 35 U.S.C. 102 (e) over Maeda et al. Claim 6 had been originally deemed allowable over Maeda. Accordingly, Applicant combined the limitations of claims 1 and 6 and also 11 and 16 in composing new base claims. However, it is now recognized that the limitations of claims 6 and 16

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would not be sufficient to render the claims allowable for the reasons provided below.

The Examiner sincerely regrets any inconvenience this may have caused the Applicant.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 6, 12, 13, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al., U.S. Patent # 6,284,363. Applicant has by way of amendment introduced the limitation that the specific surface area of the soft magnetic powder should fall in the range of 0.1 to 3 m<sup>2</sup>/g. Maeda is silent regarding this limitation reciting instead the average particle diameter of the particulate soft magnetic metal. (Although the surface area of the particles in Maeda may be calculated using the formula

$$\text{Surface area} = 4\pi r^2,$$

Assuming that the particles are spherical, this parameter is not the same as *specific* surface area which has units of meters-squared per gram. In order for this property to be calculated, knowledge of the average mass of an individual particle would be required.) Nonetheless, it is now appreciated that one of ordinary skill in the art would vary the specific surface area as a matter of routine experimentation to achieve a favorable packing density. Indeed, packing density is an important parameter in any filled polymer system where the filler is responsible for imparting a key property. For

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example, if the specific surface area of the magnetic particles of Maeda's invention was too high than a filled polymer of insufficient packing density and, hence, low suppressing capability would be expected. The relevant teachings of Maeda covering the limitations of claims 2-3 and 11-12 are provided in the paragraph bridging pages 4 and 5 of paper no. 6.

Claims 4, 5, 7-10, 14, 15 and 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Sakurai et al., U.S. Patent Application Publication # 2002/0077439 teaches a composition and suppression body similar to that of the instant invention but does not qualify as a reference as the filing date of said application does not precede the PCT date of the present filing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



MARGARET G. MOORE  
PRIMARY EXAMINER